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GROUP 1600

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Boukherroub, Rabah

Serial No: 09/803,044

Filed: March 12, 2001

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) Art Unit: 1641  
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) Examiner: CEPERLEY, MARY  
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OFFICIAL

Agent's Docket no. 10963-US

October 21, 2002

For: PASSIVATION OF POROUS SEMICONDUCTORS

Honorable Commissioner of Patent and Trademarks  
Washington, D.C. 20231

**RESPONSE TO OFFICE ACTION DATED JULY 20, 2002**

Sir:

In response to the Office Action dated July 20, 2002, applicant respectfully elects the invention of group II for examination with traverse and without prejudice to the applicant's right to pursue these claims in a divisional application. In the applicant's respectful submission, generic claim 1 includes sufficiently few species that a search and examination of all the species at one time would not impose a serious burden on the Examiner. In *In re Weber*, 198 USPQ 332, the court held upheld the right of an applicant to claim an invention as he chooses. In the applicant's respectful submission, the Examiner does not have the authority to require the applicant to arbitrarily carve up a single claim.

The mere fact that the different species may be patentable over each other does not in itself give rise to a valid restriction requirement.

While it is respectfully submitted that the restriction requirement as a whole is improper, it is particularly submitted that the restriction between groups I and II is improper. The

USSN 09/803,044

Art Unit 1641

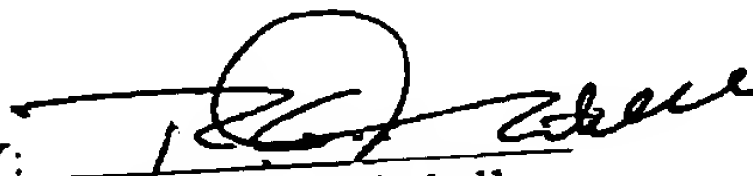
specification teaches on page 3, line 22 that while other agents may be employed the primary agents are alkenes or aldehydes, and at the very least these two agents should be examinable together in a single claim. These two agents are disclosed as alternatives in example 1 (see page 8, line 2). Examining such groups together would not create a serious burden on the PTO in that the subject matter is not separately classified since it all relates to the stabilization of porous silicon, there is no separate status in the art, and the subject matter of the alleged inventions clearly lies in the same field of art.

The Examiner is therefore respectfully requested to reconsider the restriction requirement, and at the very least not require restriction between the two primary agents, namely the alkenes and aldehydes as defined in claim 2 and as exemplified in example 1.

Reconsideration and allowance are therefore respectfully requested.

Respectfully submitted

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